

## REMARKS

The present amendment is submitted in response to the Office Action dated August 1, 2008, which set a three-month period for response, making this amendment due by November 1, 2008.

Claims 1-7 are pending in this application.

In the Office Action, the drawings were objected to for various informalities. Claims 1-7 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-7 were further rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 1006/0118341 to Huber.

With the present amendment, amended figures have been filed to address the objections. In addition, new Figs. 2d and 2e have been added to show the features of claims 3 and 4, respectively. Figs. 2d and 2d are derived from Fig. 2a. The Applicants respectfully submit that no new matter has been added, since the features of the new figures were disclosed in the specification as originally filed.

In the amendment, claim 1 was amended to address the rejection under Section 112, second paragraph, which the Applicants believe is based on a translation error in claim 1. Specifically, claim 1 was amended to correctly define "wherein the cutting plane (CP) is cut at a right angle by the cutting edge (11)..." (see Figs. 2a and 2b).

Regarding the definition of the vertical height H, the first assumption of the Examiner stated in the Office Action is correct. As shown in sectional views of Figs. 4, 5, 8 and 9, the height H is measured from the intersection of the second

free face section 10b and the first free face section 10a to the tip of the cutting edge 11. The figures show only drilling tools with constant height H of the tip. With respect to the definition of the height H, the Applicants direct the Examiner's attention to paragraphs [0022] and [0024] of the publication application:

[0022] ... First free face section 10a, which defines a rib 14 as viewed from a spacial perspective, has a vertical height H, which is measured as the distance between plane E and a further plane P extending in parallel with plane E and perpendicularly to longitudinal axis L. Plane P intersects cutting element 3 at the transition of 'first free face section 10a into second free face section 10b. Vertical height H of rib 14 has values ranging from 0.1 mm to 1.0 mm. Cutting element 3 has a width B.sub.3 which, depending on the diameter of the drilling tool, can range from 1 mm to 6 mm, e.g., when a cutting plate is provided...,

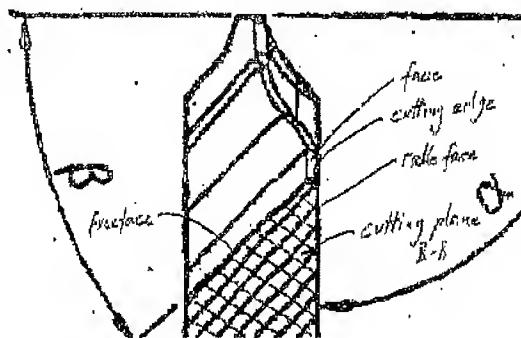
[0024] ... Vertical height H of rib 14 is indicated in FIG 8. Vertical height H is defined as a distance between planes E and P, with which longitudinal axis L are perpendicular and which intersect a cutting edge 11 and the transition from first free face section 10a into a second free face section 10b.

In order to illustrate that a first free face section is known from the Huber reference, the examiner refers to Fig. 4 of Huber (see appendix of the Office Action). The Applicants respectfully submit that Fig. 4 of Huber has been misinterpreted, since Fig. 4 shows the section A-A of Fig. 3 wherein the cutting plane A-A cuts the drilling tool at a point in which the cutting edge 4 passes into the chisel edge which connects the cutting edges 4, 4' (see especially Fig. 2 of Huber showing the horizontally directed chisel edge). Therefore the line which designated by the Examiner (see appendix of the Office Action) as "cutting edge" does not show the cutting edge but the chisel edge. The line designated by the Examiner (see appendix of the Office Action)

as "first free face section" does not show a free face of the cutting edge 4 but shows the rake face of the cutting edge 4'.

This interpretation is supported by the fact that the plane which is defined by these two lines is not shaded and therefore lies in a plane behind the cutting plane A-A. Furthermore, the cutting plane A-A shown in Figs. 3 and 4 of Huber is not oriented according to the amended claim 1.

A blown-up drawing of Fig. 5 of Huber (see below) shows that Huber does not disclose a free face which is divided into a first free face section and a second free face section, as defined in claim 1 of the present application. Rather, the cutting edge (3, 3') of Huber is followed by a small, flat, horizontally or even ascending orientated face. Because of its horizontal respectively ascending orientation this small face cannot be interpreted as a free face.



Likewise, the Applicants respectfully submit that the rejection of claim 7 is based on a misinterpretation of Fig. 4 of Huber and the previous inaccurate recitation in claim 1.

Because amended claim 1 includes features that are not disclosed by the cited reference to Huber, the rejection under Section 102 cannot stand. The Applicants furthermore respectfully submit that Huber is not a proper reference under 35 USC 102 pursuant to the guidelines set forth in the last paragraph of MPEP section 2131, where it is stated that “a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference”, and that “the identical invention must be shown in as complete detail as is contained in the … claim”. Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

The application in its amended state is believed to be in condition for allowance. Action to this end is courteously solicited. However, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,  
/Michael J. Striker/

Michael J. Striker  
Attorney for Applicant(s)  
Reg. No. 27233  
103 East Neck Road  
Huntington, New York 11743  
631-549-4700